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UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ROBERT JACOBSEN,

Plaintiff,

v.

MATTHEW KATZER, et al.,

Defendants.

No. C-06-1905-JSW

**MEMORANDUM IN OPPOSITION TO
DEFENDANT RUSSELL MOTION TO
STRIKE CLAIMS 5 AND 7**

Date: August 11, 2006
Time: 9:00 a.m.
Courtroom: 2, 17th Floor
Judge: Hon. Jeffrey S. White

Filed concurrently:

1. Declaration of Robert Jacobsen
2. Declaration of Hans Tanner
3. Proposed Order

1 SUMMARY OF ARGUMENT

2 Filing a FOIA request is not a constitutionally protected activity, but a business transaction
 3 that does not fall within the ambit of the Anti-SLAPP statute, Cal. Civ. P. § 425.16. This statute
 4 protects certain activities based on the constitutional right to petition and free speech, such as.
 5 making statements at official government meetings, as well as making complaints or reports to
 6 government agencies to prompt an investigation or remedy a harm. But the statute does not give
 7 protection to all communications with the government – only those based in the constitutional
 8 petitioning or free speech right. Bosley Medical Institute, Inc. v. Kremer, 403 F.3d 672 (9th Cir.
 9 2005); City of Cotati v. Cashman, 29 Cal. 4th 69 (Cal. 2002). Filing a FOIA request is neither a
 10 complaint nor a report to prompt a government investigation or remedy a harm, but is a ministerial
 11 act like a business transaction – money in exchange for copies and records, and thus, is
 12 unprotected. Furthermore, there is no constitutional right to non-public government information.
 13 Thus, filing a FOIA request does not constitute a statement before an official proceeding.

14 The FOIA request is not a statement before a judicial proceeding because litigation
 15 privilege does not apply here. For litigation privilege to apply, four elements must be met:
 16 proposed litigation, made in good faith, with litigation imminent, and the proposal made for the
 17 purpose to resolve the dispute. Mezetti v. State Farm Mutual Auto. Ins. Co., 346 F. Supp. 2d 1058
 18 (N.D. Cal. 2004). Here, no litigation was proposed, and it was not imminent. As discussed below,
 19 the actions of Russell and Katzer could never seriously have been undertaken in the good faith
 20 contemplate litigation. Thus, Russell cannot raise litigation privilege to protect him from liability.

21 Even if the court finds that filing a FOIA request is a constitutionally protected activity, Mr.
 22 Jacobsen has a probability of success on his § 17200 claim. Mr. Jacobsen lost money due to
 23 Russell's unlawful, unfair or fraudulent business practices. Thus, he has standing to bring the
 24 action. Immunity under Cal. Civ. § 1714.10 is not available to Russell since he violated an
 25 independent duty he owed to Mr. Jacobsen. As for a remedy, Mr. Jacobsen seeks injunctive relief,
 26 and thus has a remedy available to him when he prevails. Because filing a FOIA request is a
 27 business transaction and not a constitutionally protected petitioning activity to redress harms, this
 28 court should deny Defendant Russell's Motion to Strike Claims 5 and 7.

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ISSUES TO BE DECIDED

Is the filing of a FOIA request, in which there is a business transaction – mere exchange of information for a fee – an official proceeding when no First Amendment right to petition for redress of harms is triggered?

Does the litigation privilege apply when the parties who appeared to be threatening litigation knew they have no good faith and serious basis for bringing suit and the facts show suit was not imminent?

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

This is a case in which a so-called inventor, Defendant Matt Katzer (“Katzer”), stole ideas from others, patented them and then tried to crush competitors by attempting to enforce the patent. Katzer worked with an attorney, Defendant Kevin Russell (“Russell”), to prosecute his patent applications and trademark applications. Through Russell, Katzer has obtained 11 U.S. patents. From the very first patent application (‘461 application) filed on June 24, 1998, Russell had in his possession 4 prior art references, each of which, inter alia, constituted a prima facie case of unpatentability.¹ Russell never produced these references to the United States Patent and Trademark Office (USPTO). Thus, he committed inequitable conduct, which made the patent and its related patents unenforceable. In late 2002, manufacturers whom Russell sent threatening letters, confronted Russell with inequitable conduct charges, and more prior art. During this same time frame, Russell had 2 applications open for prosecution on the merits, and was required by law to make the patent examiner aware of material references. He failed to produce any of these or the earlier references. In January 2006, Mr. Jacobsen filed a complaint with the Office of Enrollment and Discipline (OED) alleging that Russell engaged in inequitable conduct after Russell accused him of infringement, filed a FOIA request with Mr. Jacobsen’s employer, and sent him numerous

¹ “A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.” 37 C.F.R. § 1.56(b).

1 letters styled as “bills” for patent royalties allegedly owed to Katzer. During this January 2006
 2 time period, Russell had an application open for prosecution on the merits that was a continuation
 3 of the patents prosecuted during the late 2002 timeframe. Despite owing a duty to disclose these
 4 references, he still did not produce the prior art for the patent examiner. Only when served with
 5 this lawsuit did Russell finally produce some of the references to the USPTO. On April 3, 2006,
 6 when a 12th Katzer patent was on the verge of issuing, Russell filed a Request for Continued
 7 Examination, citing as the reason for the request a violation of Rule 56 and the illegality of the
 8 application. This 12th application was a continuation of the ‘461 application from which the
 9 patent-in-suit claims benefit.

10 Mr. Jacobsen has sued Russell for committing intentional torts, actual fraud, and unlawful
 11 acts against him. Russell seeks to strike these claims under the anti-SLAPP Act or defeat them by
 12 raising privilege or immunity granted to attorneys by statute. Because filing the FOIA request is
 13 not a constitutionally protected activity, the court should deny Russell’s motion. Even if the court
 14 agrees that the filing of the FOIA request is a protected activity, Mr. Jacobsen’s Cal. Bus. & Prof.
 15 Code § 17200 claim survives. Russell cannot raise litigation privilege under Cal. Civ. § 47(b) and
 16 immunity under Cal. Civ. § 1714.10 to protect him from liability for all intentional torts, fraud and
 17 unlawful acts he committed against Mr. Jacobsen.

18 **II. FACTS**

19 Throughout the 1990s, Katzer developed various products for KAM Industries, now called
 20 KAMIND Associates, Inc. These products included Train Tools, Train Server, Computer
 21 Dispatcher, and Engine Commander. Jacobsen Decl. ¶¶ 119-25. Katzer advertised these products
 22 for sale in Model Railroader magazine, beginning in 1995. Jacobsen Decl. ¶¶ 92-94. Engine
 23 Commander was advertised in the January 1995 issue of Model Railroader. Jacobsen Decl. ¶ 92.
 24 By December 18, 1996, Katzer was advertising that it would be available for shipment in January
 25 1997, and would offer “[d]ual controller support on multiple serial ports (1-10) so that you can run
 26 one controller on one port and another controller on another port.” Jacobsen Decl. ¶ 126. This is
 27 an embodiment of the invention. Jacobsen Decl. ¶ 127. Katzer also admitted on his website that
 28 the products were available for sale beginning in 1996. Jacobsen Decl. ¶ 127. According to

1 Katzer, “Train Server is such an innovative and unique programming environment that that
2 numerous patents (see footnotes ...) have been granted to KAM both [sic] in the United States,
3 Germany, Great Britain, Canada and other countries.” Id. The footnotes Katzer refers to include
4 all 10 U.S. patents that had issued at the time, including ‘406, the patent that issued from the first
5 application, and ‘329, the patent-in-suit. Id.

6 On Jan. 14, 1998, Russell filed several trademark applications on behalf of Matt Katzer and
7 Barbara Dawson. Jacobsen Decl. ¶¶ 121-24. Among them were “Train Server” and “Engine
8 Commander”. The first use in commerce of “Train Server” was on or before June 1997, and of
9 “Engine Commander” was on or before Jan. 1, 1993. Jacobsen Decl. ¶¶ 121, 123.

10 On June 24, 1998, Russell filed the first in a series of patent applications on Katzer’s
11 behalf. Jacobsen Decl. ¶ 102. In this application, Russell identified in the Background of the
12 Invention section of the patent a software program by DigiToys of Lawrenceville, Georgia. See
13 Tanner Decl. ¶¶ 18, 24. The software program, WinLok, had a user’s manual, but Russell did not
14 list it on the Information Disclosure Sheet. Tanner Decl. ¶¶ 5,8; see Jacobsen Decl. ¶ 108. The
15 user’s manual discloses WinLok features that were claimed by Katzer in his first patent
16 application. Jacobsen Decl. ¶ 107. In the application, Russell identified several KAM Industries
17 programs including Train Server and Engine Commander, and stated copyrights for these programs
18 as beginning in 1992. Jacobsen Decl. ¶ 141. Katzer had advertised these programs for sale
19 beginning in 1996, and had discussed them and their capabilities in his presentations at National
20 Model Railroad Association (NMRA) conferences. Jacobsen Decl. ¶¶ 116-18, 128. Engine
21 Commander and Train Server each had capabilities that included the “invention” claimed in the
22 first patent application. Jacobsen Decl. ¶¶ 119, 126-27 .

23 In 2001, Bob Jacobsen and other model train enthusiasts began an open source project for a
24 new model train control systems software. See Jacobsen Decl. ¶ 9. On March 27, 2002, JMRI
25 posted a notice about changes that would appear in the next version of the software. Jacobsen
26 Decl. ¶ 62. Among the capabilities were multiple programs running multiple trains at the same
27 time on the same model train layout. Id. The release was posted and publicly announced on April
28 14, 2002. Id. The notice was sent to internet listservs, a type of internet based bulletin board, that

1 Matt Katzer belongs to. Jacobsen Decl. ¶¶ 70-73. On April 17, 2002, Russell filed a continuation
2 application (the '878 application) with claims that copied the capabilities in the new JMRI release.
3 Jacobsen Decl. ¶¶ 67-69, 79.

4 On September 18, 2002, after several patents issued, Russell, acting on behalf of Matt
5 Katzer, first filed a protective lawsuit and then sent a cease and desist letter to Mireille Tanner,
6 wife of Hans Tanner. Tanner Decl. ¶¶ 17-19; Jacobsen Decl. ¶ 109. Hans and Mireille Tanner
7 own DigiToys, the maker of the software program identified in the first, and all, patent
8 applications. Tanner Decl. ¶ 24. Hans Tanner wrote Russell on Oct. 3, 2002, and deposited letters
9 into the file wrappers of the three patents Katzer and Russell accused him of infringing. Tanner
10 Decl. ¶¶ 21, 33. Dr. Tanner's letters stated that the accused capabilities of his program were
11 present in versions of WinLok that pre-dated Katzer's earliest patent filing date, and that a user's
12 manual included with WinLok 2.0 identified these capabilities. Tanner Decl. ¶ 25. Dr. Tanner also
13 accused Katzer of violating 37 C.F.R. § 1.56. Tanner Decl. Ex. F. In December 2002, Russell
14 dismissed the lawsuit against Tanner without serving him. Jacobsen Decl. ¶ 109.

15 At the time Russell received the letter from Dr. Tanner, the '878 application was still open
16 for prosecution on the merits. Jacobsen Decl. ¶ 69. Russell did not produce the references
17 identified by Dr. Tanner to the patent examiner. Id. Prosecution on the merits closed on Nov. 4,
18 2002, and the '329 patent issued on Mar. 11, 2003. Id.

19 Beginning in March 2005, Russell sent letters to Mr. Jacobsen accusing him of patent
20 infringement. Jacobsen Decl. ¶¶ 26-27. In August 2005, Russell included "sale receipt" for more
21 than \$200,000. Jacobsen Decl. ¶¶ 30-31. Russell sent letters on a roughly monthly basis
22 afterward, including invoices for more than \$200,000 and with interest added. Jacobsen Decl. ¶ 40.
23 Then, in October 2004, Russell filed a FOIA request with the U.S. Department of Energy. See
24 Russell Ex. 4. He accused Mr. Jacobsen of infringing KAMIND Associates patents. Jacobsen
25 Decl. ¶ 35. Russell authorized the payment of up to \$5,000 for copies of Mr. Jacobsen's e-mails,
26 among other items. Katzer Decl. Ex. 1. The Department of Energy classified the request as a
27 "commercial use" request, Katzer Decl. Ex. 1, which is a request by "one who seeks information
28 for a use or purpose that furthers the commercial, trade, or profit interests of the requester or the

1 person on whose behalf the request is made.” 10 C.F.R. § 1004.2. Mr. Jacobsen is a physics
 2 researcher at a prestigious research facility. Jacobsen Decl. ¶¶ 3, 5. He cannot use his mail at
 3 Lawrence Berkeley Lab (Lab) to infringe copyrights or patents. Jacobsen Decl. ¶¶ 47-48. If he
 4 does so, he can be fired. Jacobsen Decl. ¶ 49. Moreover, accusations of using another’s work
 5 without giving that person credit destroy careers. Jacobsen Decl. ¶ 53. At UC Berkeley, where
 6 Mr. Jacobsen teaches, it is one of only two bases that can cause a tenured professor to be fired.
 7 Jacobsen Decl. ¶ 51. After the FOIA request was forwarded to the Lab, Mr. Jacobsen was called
 8 into his boss’ office at the Lab and ordered to explain why Russell had filed the FOIA request.
 9 Jacobsen Decl. ¶ 39. The accusation embarrassed Mr. Jacobsen. Id. After Russell sent Plaintiff
 10 Robert Jacobsen numerous bills and harassing letters, and filed the FOIA request, Mr. Jacobsen
 11 filed the present action. Included is a claim for libel for making a false statement that Mr. Jacobsen
 12 is infringing an allegedly valid and enforceable patent. Given that Mr. Jacobsen is a researcher
 13 working in a field where he must give other people credit for their work or else face serious
 14 charges, Russell’s statement constituted libel.

15 Subsequent to the FOIA request, Mr. Jacobsen filed a complaint with the USPTO Office of
 16 Enrollment and Discipline alleging inequitable conduct. As a direct result of this complaint,
 17 Russell filed an RCE on an open, continuation patent application on April 3, 2006.

18 **III. ARGUMENT**

19 The anti-SLAPP act covers constitutionally protected activity, such as filing of lawsuits,
 20 statements made at hearings, or reports to government agencies to prompt an investigation or
 21 remedy a harm. It does not protect all contacts or communications with the government. For a
 22 defendant to successfully strike a claim under the anti-SLAPP act, he must show that the claim is
 23 based on a constitutionally protected activity. Bosley Medical Institute, Inc. v. Kremer, 403 F.3d
 24 672, 682 (9th Cir. 2005). If he cannot make a showing, his motion to strike fails. If he succeeds,
 25 then the burden shifts to the plaintiff to show he has a probability of succeeding. A.F. Brown Elec.
 26 Contractor, Inc. v. Rhino Elec. Supply, Inc., 137 Cal. App. 4th 1118, 1125 (Ct. App. 2006). Here,
 27 Russell claims that the FOIA filing is a statement made before an official proceeding authorized by
 28 law. He also claims that the FOIA filing was done in preparation for filing a lawsuit, and thus is

1 protected as a statement made before a judicial proceeding. But as the facts and precedent will
 2 show, Russell's FOIA request does not constitute a protected activity under the anti-SLAPP Act
 3 because it is not based on the constitutional right to petition the government for redress of harms.

4 **A. Filing a FOIA request does not constitute making a statement before an official**
 5 **or judicial proceeding**

6 1. What constitutes a protected activity under the anti-SLAPP Act

7 The anti-SLAPP statute, Cal. Civ. P. § 425.16, provides broad protection for some, but not
 8 all contacts, with the government. Coverage is only for those acts that are based on constitutionally
 9 protected activities, as defined by the statute. The statute makes a protected activity "any written
 10 or oral statement or writing made before a legislative, executive, or judicial proceeding, or any
 11 other official proceeding authorized by law....". Cal. Civ. Code § 425.16(e)(1). This protection is
 12 broad, and covers not only statements made before a hearing held by one of these bodies, but also
 13 statements made to these bodies to prompt an investigation or to seek a remedy. See e.g., Briggs v.
 14 Eden Council for Hope & Opportunity, 19 Cal.4th 1106, 1115 (1999) (claim based on report to
 15 HUD and action in civil courts stricken); Fontani v. Wells Fargo Investments, LLC, 129 Cal. App.
 16 4th 719, 729-30 (Ct. App. 2005) (U-5 form required to be filed with NASD; one of its purposes is
 17 to "trigger a regulatory investigation where warranted", thus claim based on its filing was stricken);
 18 ComputerXpress, Inc. v. Jackson, 93 Cal. App. 4th 993, 1009 (Ct. App. 2001) (claim based on
 19 complaint to SEC stricken); Wise v. Thrifty Payless, Inc., 83 Cal. App. 4th 1296, 1301-02 (Ct.
 20 App. 2000) (report to DMV was made to trigger investigation; if claim based on report to DMV
 21 had been included, it would have been stricken); Dove Audio, Inc. v. Rosenfeld, Meyer &
 22 Susman, 47 Cal. App. 4th 777, 784 (Ct. App. 1996) (claim based on collection of information in
 23 preparation for report to Attorney General stricken due to litigation privilege; no question arose
 24 that litigation privilege applied).

25 But not all contacts or communications with the government are protected activities. "No
 26 lawsuit is properly subject to a special motion to strike under section 425.16 unless its allegations
 27 arise from acts in furtherance of the right to petition or free speech." Kajima Eng'g &
 28 Construction, Inc. v. City of Los Angeles, 95 Cal.App.4th 921, 924 (Ct. App. 2002). "[T]he

critical point is whether the plaintiff's cause of action itself was based on an act in furtherance of the defendant's right of petition or free speech.” City of Cotati v. Cashman, 29 Cal. 4th 69, 78 (Cal. 2002). A statement made to a government entity as a part of a ministerial act or business transaction is not a protected activity. Blackburn v. Brady, 116 Cal. App. 4th 670, 676-78 (Ct. App. 2004). Recent Ninth Circuit case law supports the view that a minor business transaction does not fall within the ambit of the anti-SLAPP Act. Bosley Medical Institute, Inc. v. Kremer, 403 F.3d 672, 682 (9th Cir. 2005) (lawsuit based on domain name dispute does not involve First Amendment rights per se, thus anti-SLAPP does not apply). The statute does not cover statements that have a remote chance of being used in litigation. People ex rel. 20th Century Ins. Co. v. Building Permit Consultants, Inc., 86 Cal. App. 4th 280, 284-85 (Ct. App. 2000) (claim based on fraudulent statement made allegedly in anticipation of litigation not covered by statute). “Hollow threats” of litigation, which are really tactical ploys to negotiate bargains, are not protected. Mezetti v. State Farm Mutual Auto. Ins. Co., 346 F. Supp. 2d 1058, 1065 (N.D. Cal. 2004).

Russell argues that the filing of the FOIA request is a statement made before an official proceeding – the Department of Energy (DOE). He also argues that the FOIA request is a statement made before a judicial proceeding, as an act done in preparation for litigation. The facts and the case law do not support him, and thus the court should deny his anti-SLAPP motion.

2. The FOIA request is not a statement made before DOE because it would not have led to an investigation or remedy, but a production of documents

Russell’s libelous statements are not statements made before an official proceeding, as that term is defined by the statute. Rather these statements were made during the course of a business or commercial transaction. Katzer offered to pay DOE \$5,000 in exchange for information relating to Mr. Jacobsen’s activities at the Lab. Clearly, an offer of \$5,000 in exchange for information is not the type of speech that § 425.16 was designed to protect. By arguing that it does, Russell invites this Court to broaden the applicability of § 425.16 to include minor business transactions between a citizen and the government, a broadening not envisioned by the drafters of § 425.16 . The Court should not accept this invitation.

As noted above, protected activities are those based on the right to petition the government

1 for redress of harms, or the right to free speech. Common to all cases cited by Russell where
 2 claims were stricken under the anti-SLAPP Act, are complaints made to the government, or
 3 investigations leading to complaints to be made to the government – protected “on the theory that
 4 open communications is a fundamental adjunct to the right of access to ... proceedings.” Edwards
 5 v. Centex Real Estate Corp., 53 Cal. App. 4th 15, 30 (Ct. App. 1997). Even in Fontani, which
 6 should be considered the high water mark for protected activities, one purpose for the U-5 form in
 7 which defendant Wells Fargo used to report broker-dealer Fontani, was to trigger a regulatory
 8 investigation where warranted. Fontani v. Wells Fargo Investments, LLC, 129 Ca. App. 4th 719,
 9 729 (Ct. App. 2005). The court used this as a basis for finding that the filing of that form was a
 10 protected activity. Id. at 730. Unlike these activities, which are protected under the right to
 11 petition the government for redress of harms, there is no constitutional right to a FOIA request.
 12 McGehee v. Casey, 718 F.2d 1137, 1147 (D.C. Cir. 1983) (“[C]itizens have no first amendment
 13 right of access to traditionally non-public government information.”) “The basic purpose of FOIA
 14 is to ensure an informed citizenry....” NLRB v. Robbins Tire & Rubber Co., 437 U.S. 214, 242
 15 (1978). Further, the purpose of the FOIA is to get information, not to prompt an investigation. 10
 16 C.F.R. § 1004.1 (“Records of the DOE made available pursuant to the requirements of 5 U.S.C.
 17 552 shall be furnished to members of the public as prescribed by this part.”); 10 C.F.R. § 1004.4
 18 (describing elements of a request); 10 C.F.R. 1004.5 (describing procedure for processing
 19 requests); 10 C.F.R. § 1004.9 (describing fees for document search and production). Thus, the
 20 FOIA request is not based on the right to petition for redress of harms. The claim for libel is not
 21 based on a complaint to the U.S. Department of Energy or UC Berkeley to prompt an investigation
 22 because Russell never filed a complaint. He filed a request for information. Thus, the claim for
 23 libel cannot be based on a non-existent protected activity, and Russell’s argument fails.

24 Russell argues that a FOIA request is a statement before an official meeting authorized by
 25 law and cites Fontani as support that because it was intended to “prompt action” by the Department
 26 of Energy. For support, Russell includes a declaration from his client, Katzer, who conveniently
 27 states now – for the sole purpose of trying to bootstrap a protected activity to claim the benefit of
 28 the anti-SLAPP statute – that the filing was meant to warn the Department of Energy that it was

engaging in infringing activities.² First, there is no “cease and desist” warning in the FOIA itself. Russell Decl. Ex. 4. Next, aside from the fact that offering \$5,000 to try to prompt official action smacks of attempted bribery, not all contacts or communications with the government are protected activities under the anti-SLAPP Act. The FOIA request, which in essence is a business transaction – an exchange of money for documents, is not a protected activity. Next, Fontani does not support Russell’s assertion that the filing is a protected activity. As noted above, in Fontani, the court held that because one of the purposes of the U-5 form, in which the allegedly defamatory statement was made, was to prompt action by the NASD to discipline broker-dealers, the filing of the U-5 form was a protected activity. A review of the DOE Code of Federal Regulations section on FOIA shows that no government inquiry into the alleged infringement would have resulted from the FOIA request. No remedy would have been given. The only thing that would have resulted is a search for records, and a production of those records, in exchange for a payment of up to \$5,000 – a business transaction. Thus, because the statement was made neither at a government agency hearing, nor to the agency to prompt official action to investigate a complaint, or remedy a harm, the filing of a FOIA request is not a protected activity made before an official proceeding authorized by law.

3. The FOIA request was not made before a judicial proceeding because litigation privilege does not apply

Russell’s libelous statements were not made before a judicial proceeding as defined by statute and precedent, and accordingly are not protected. Filing a lawsuit constitutes a protected activity under § 425.16. Navellier v. Sletten, 29 Cal. 4th 82, 90 (Cal. 2002). But Russell never filed a lawsuit against Mr. Jacobsen – although he lied in the FOIA request and said there was a lawsuit to scare Mr. Jacobsen. Russell Decl. Ex. 4. Russell did file lawsuits against Freiwald Software and some of its distributors, and against Mireille Tanner, before sending them “cease and desist” letter, but not Mr. Jacobsen. Activities in preparation for litigation are protected, but only

² This assertion is ridiculous. The Lawrence Berkeley Lab is a research facility, not a hotbed of model train control systems software production. Jacobsen Decl. ¶ 5. The discussion in § III.A.3 shows that Katzer knew that JMRI was a group of hobbyists and that it was not sponsored by an entity.

1 when done in serious and good faith contemplation of litigation. Mezetti v. State Farm Mutual
 2 Auto. Ins. Co., 346 F. Supp. 2d 1058 (N.D. Cal. 2004) (describing litigation privilege under Cal.
 3 Civ. § 47(b)).³ Four elements must be present for privilege to attach:

4 First, “the communication must have been made preliminary to a proposed judicial
 5 or quasi-judicial proceeding.” Second, “the verbal proposal of litigation must be
 6 made in good faith.” Third, “the contemplated litigation must be imminent.”
 7 Fourth, “the litigation must be proposed in order to obtain access to the courts for
 8 the purpose of resolving the dispute.” The court noted that “[t]he critical point of
 9 each of these four elements is that the mere potential or ‘bare possibility’ that
 10 judicial proceedings ‘might be instituted’ in the future is insufficient to invoke the
 11 litigation privilege.”

12 Mezetti, 346 F. Supp. 2d at 1065 (quoting Edwards v. Centex Real Estate Corp., 53 Cal.
 13 App. 4th 15, 35 (Ct. App. 1997)) (citations omitted). “In every case, the privileged communication
 14 must have some relation to an imminent lawsuit or judicial proceeding which is actually
 15 contemplated seriously and in good faith to resolve a dispute, and not simply as a tactical ploy to
 16 negotiate a bargain.” Id. (quoting Edwards, 53 Cal. App. 4th at 36) (emphasis in original). “The
 17 bare possibility that the proceeding might be instituted is not to be used as a cloak to provide
 18 immunity when the possibility is not considered.” Visto Corp. v. Sprogit Techs., Inc., 360 F. Supp.
 19 2d 1064, 1069 n.3 (N.D. Cal. 2005). Whether Russell’s activities were taken in preparation of
 20 litigation is a question of fact to be resolved before privilege applies. Eisenberg v. Alameda
 21 Newspapers, Inc., 74 Cal. App. 4th 1359, 1379 (Ct. App. 1999). Here, because of the 1-year delay,
 22 and Russell’s admission of illegal conduct in prosecuting the patents,⁴ Russell and Katzer – despite
 23 their threats – could not have seriously and in good faith contemplated litigation against Mr.
 24 Jacobsen. Instead, their FOIA request was a “tactical ploy” unworthy of protection under litigation
 25 privilege. Analysis of the facts demonstrates this.

26 First, the statement must be made preliminary to proposed litigation. For 1 year, Russell
 27 sent letters accusing Mr. Jacobsen of infringement, but he never filed a lawsuit against Mr.
 28 Jacobsen, although he lied about it to the DOE. Russell admits that the purpose of the letters to Mr.

³ “[C]lauses (1) and (2) of section 425.16, subdivision (e) ... are coextensive with the litigation
 privilege under Civil Code section 47(b).” A.F. Brown Elec. Contractor, Inc. v. Rhino Elec.
Supply, Inc., 137 Cal. App. 4th 1118, 1125 (Ct. App. 2006).

⁴ E.g. Consolidated Aluminum Corp. v. Foseco Int’l Ltd., 910 F.2d 804, 809 (Fed. Cir. 1990).

1 Jacobsen was to “engag[e] his attention to this manner [sic].” Russell Decl. ¶ 7. He said he
2 “cautioned” Mr. Jacobsen, “suggest[ed] how the JMRI product may be modified”, and “offer[ed] to
3 license the patent” to Mr. Jacobsen. Russell Decl. ¶ 4. There was no proposed litigation.

4 Second, the proposal – if the court finds any – needs to have been made in good faith. As
5 noted, Russell knew from the very beginning that he and Katzer had committed inequitable
6 conduct, and obtained patents that would have been barred under § 102(b). At the time he filed
7 the first patent application, Russell had in his possession four references – Engine Commander,
8 Train Server, WinLok 1.5 and WinLok 2.0 – which each constituted a prima facie case of
9 unpatentability. He never produced them for the patent examiner, although he was under a duty to
10 do so. 37 C.F.R. § 1.56(c)(2). The consequences of not notifying the examiner could be severe,
11 and include suspension or exclusion from practice before the USPTO. Manual of Patent
12 Examining Procedure (MPEP) § 10.130(a). On two occasions, Russell was confronted with
13 charges of inequitable conduct. On both occasions, Russell had patent applications that were open
14 for prosecution on the merits, one of which issued as the ‘329 patent-in-suit. Russell still did not
15 produce references. A reasonable attorney would have known the consequences of filing a lawsuit
16 – discipline and unenforceability of the patents due to inequitable conduct – and would have
17 known he could not move forward with litigation. With the sword of Damocles over his and
18 Katzer’s heads, Russell could not have been proposing litigation to Mr. Jacobsen in good faith.

19 Third, the contemplated litigation must be imminent. The facts here show that litigation
20 was not imminent. Five months passed after the FOIA request was filed, and Russell did not file
21 litigation. He just continued to harass Jacobsen. He could do little else because of the massive
22 inequitable conduct and fraud on the USPTO that he and Katzer committed.

23 Finally, the litigation must be proposed in order to obtain access to the courts for the
24 purpose of resolving the dispute. Here it was not. As demonstrated by the exhibits, any litigation
25 brought by defendants would never ended in their favor, and they knew it. If any litigation was
26 proposed, it was a mere tactical ploy to get Mr. Jacobsen to shut down his project and hand over
27 more than \$200,000 to Katzer.

28 Russell argues that the filing of the FOIA request was done in anticipation of litigation and

1 sent to the DOE to warn the DOE of its infringing activities. As noted earlier, there was no “cease
 2 and desist” warning in the FOIA. Further, “... FOIA was not intended to function as a private
 3 discovery tool.” NLRB v. Robbins Tire & Rubber Co., 437 U.S. 214, 242 (1978). Katzer states –
 4 apparently with a straight face – that he believed that the U.S. Department of Energy was
 5 sponsoring the JMRI project. Katzer Decl. ¶ 3. This is simply not the case.⁵ In the world of
 6 model train control systems, there are few players and they all know each other or know of each
 7 other. Jacobsen Decl. ¶ 16. Katzer and Jacobsen have known each other since 2001 when Mr.
 8 Jacobsen first contacted Katzer about control systems for model trains. Jacobsen Decl. ¶¶ 14, 17.
 9 Katzer knew it was a fellow hobbyist creating the software. Jacobsen Decl. ¶¶ 14-22. He knows
 10 that other people working on the JMRI project are fellow hobbyists. Jacobsen Decl. ¶ 25. Katzer
 11 attended the same NMRA conferences that Jacobsen did. Jacobsen Decl. ¶ 17. Katzer gave
 12 presentations and workshops on his software at these conferences. Jacobsen Decl. ¶ 18. Jacobsen
 13 did the same for JMRI. Jacobsen Decl. ¶ 19. Katzer occasionally attended JMRI presentations.
 14 See Jacobsen Decl. ¶ 20. Never once at any presentation did Jacobsen or anyone else associated
 15 with the project state or infer that DOE was sponsoring the project. Jacobsen Decl. ¶¶ 21-22;
 16 Tanner Decl. ¶¶ 37-43. Thus, Katzer’s reason for sending the FOIA is a lie, and the truth emerges -
 17 - Katzer and Russell used the FOIA to further their admittedly illegal conduct and to harass of Mr.
 18 Jacobsen. Clearly, based upon Katzer’s admission of illegal conduct via Russell to the USPTO
 19 their threats were not made in serious and good faith contemplation of litigation. Thus, their
 20 actions are not statements made before a judicial proceeding, and their activities are not protected
 21 under the anti-SLAPP act.

22
 23 ⁵ He also states that he “had no knowledge of Mr. Jacobsen’s employment status, either with the
 24 DOE or any other employer.” Katzer Decl. ¶ 6. But in Paragraph 4.d of his declaration, Katzer
 25 states “I determined that the lbl.gov email address was associated with the DOE.” Furthermore, by
 26 going to the www.lbl.gov address, and selecting “Scientific Programs” on the web page, one will
 27 find approximately 25 National User Facilities and Scientific Divisions – one of which is the
 28 Physics Division. Mr. Jacobsen’s association with LBL is not apparent from the website. One
 needs to perform a search to determine that Mr. Jacobsen works at the Physics Division. While
 Katzer states that he had no knowledge of Mr. Jacobsen’s status, the truth is that Katzer knew
 enough about Mr. Jacobsen’s employment to target the FOIA request directly to the “Physics
 Division Berkley [sic] Livermore Labs”, where Mr. Jacobsen worked. Katzer Decl. Ex. 1.

B. Mr. Jacobsen has a probability of prevailing on his § 17200 claim

The facts as they presently exist show that Russell and Katzer engaged in a number of illegal and unlawful acts⁶ such that Mr. Jacobsen has a probability of prevailing on his § 17200 claim. If a defendant can succeed at showing his activity falls within § 425.16's ambit, then the burden shifts to the plaintiff to show that he has a probability of prevailing on the merits. Equilon Enters., LLC v. Consumer Cause, Inc., 29 Cal. 4th 53, 67 (Cal. 2002). The court considers the pleadings and the declarations of both parties. Id. If the court believes that Russell's actions constitute a protected activity under § 425.16, then Mr. Jacobsen concedes that he will not prevail on his libel claim. E.g., Fontani v. Wells Fargo Investments, LLC, 129 Cal. App. 4th 719, 729-30 (Ct. App. 2005); ComputerXpress, Inc. v. Jackson, 93 Cal. App. 4th 993, 1009 (Ct. App. 2001). However, libel is only one part of Mr. Jacobsen's § 17200 claim, and he is able to make a showing that he will prevail on his § 17200 claim. "Where a cause of action refers to both protected and unprotected activity and a plaintiff can show a probability of prevailing on any part of its claim, the cause of action is not meritless and will not be subject to the anti-SLAPP procedure." Mann v. Quality Old Time Service, Inc., 120 Cal. App. 4th 90, 106 (Ct. App. 2004).

California Business & Professions Code 17200 et seq. prohibits unlawful, unfair or fraudulent business activities. A plaintiff who has suffered injury in fact and lost money or property can bring an action under § 17200 for injunctive relief. Id. § 17204. Here, due to Russell's actual fraud and unlawful conduct, Mr. Jacobsen lost earnings, and hence was damaged. Complaint ¶ 96.h; Jacobsen Decl. ¶ 46. Thus, Mr. Jacobsen has standing to bring a § 17200 claim. To prevail under § 17200, Mr. Jacobsen must show that Russell engaged in an unlawful, unfair or fraudulent business practice. Mr. Jacobsen can make this showing.

Russell committed actual fraud against Mr. Jacobsen. Actual fraud in California consists of: (1) a misrepresentation, (2) knowledge of its falsity, (3) intent to defraud, (4) justifiable reliance, and (5) resulting damages. Gil v. Bank of America, Nat'l Ass'n., 138 Cal. App. 4th 1371,

⁶ During discovery we intend to vigorously pursue additional facts from Russell regarding, among others things, the how, when and where relating to Russell's learning of and subsequent admission of illegal conduct on the part of his client, Katzer.

1 1381 (Ct. App. 2006). The patents are unenforceable. Russell knew, because of his and his
 2 client's inequitable conduct, that the Katzer patents were unenforceable. Russell sought to obtain
 3 money for patents that are unenforceable, and thus he intended to defraud Mr. Jacobsen. Mr.
 4 Jacobsen, concerned about the repeated harassment, had to investigate Russell's assertions. Mr.
 5 Jacobsen lost income because of Russell's continued insistence that the Katzer patents were valid
 6 and enforceable. Jacobsen Decl. ¶ 46. All elements are met. Thus, this claim stands.

7 Russell committed a crime against Mr. Jacobsen when he sent the invoices to him. Under
 8 Cal. Civ. § 1716, it is punishable by a fine and jail time to send a person an invoice when it is a
 9 solicitation for an order, unless the invoice meets certain statutory requirements. Cal. Civ. §
 10 1716(a) ("It is unlawful for a person to solicit payment of money by another by means of a written
 11 statement or invoice, or any writing that reasonably could be considered a bill, invoice, or
 12 statement of account due, but is in fact a solicitation for an order...."). Russell sent an invoice for
 13 \$203,000 on Aug. 24, 2005. Russell Decl. Ex. 3. He called it an "invoice". Russell Decl. ¶ 7. He
 14 sent another invoice on Oct. 24, 2005 for \$206,047.96. He attempted to send another letter on
 15 November 23, 2005 with an invoice. On Jan. 3, 2006, he sent another letter with an invoice for
 16 \$209,382.74. Russell admits in his declaration that the invoice he sent was in reality a request for
 17 royalty payments. Russell Decl. ¶ 6. Thus, the invoice that Russell sent was in fact a solicitation
 18 for an order. Thus, Russell violated Cal. Civ. § 1716, and Mr. Jacobsen's § 17200 claim stands.

19 Russell committed antitrust violations. Under usual circumstances, an attorney will not be
 20 liable for antitrust violations. But "an attorney is not immune from antitrust liability if he becomes
 21 an active participant in formulating policy decisions with his client to restrain competition."
 22 Amarel v. Connell, 102 F.3d 1494, 1522 (9th Cir. 1997) (citation omitted). Although Russell
 23 argues that he was merely an adviser, in truth he was involved from the very start. With 4 material
 24 references, each of which provided a prima facie case of unpatentability, in front of him, Russell
 25 repeatedly violated the law and ethics rules for years, looked the other way and sought patents for
 26 Katzer – 11 of them. Knowing the patents were unenforceable and likely invalid, Russell engaged
 27 in a pattern of enforcement against competitors to shut them down or force them to pay royalties –
 28 royalties which he knew Katzer was never entitled to. Thus, he was part of the policy decision at

